

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte JOSEPH F. OUELLETTE

Appeal No. 2002-1792
Application No. 09/467,577

ON BRIEF

Before COHEN, ABRAMS, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 19, which are all of the claims pending in this application.

We AFFIRM-IN-PART and REMAND.

BACKGROUND

The appellant's invention relates to an air conveyor guide rail. A copy of the claims under appeal is set forth in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Fairman et al. (Fairman)	4,828,434	May 9, 1989
Lenhart (Lenhart '423)	5,549,423	Aug. 27, 1996
Lenhart (Lenhart '307)	6,042,307	Mar. 28, 2000

Claims 1 to 3, 5, 6, 9 to 13, 15, 16 and 19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Lenhart '423.

Claims 1 to 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Lenhart '307.

Claims 1 to 19 stand rejected under 35 U.S.C. § 103 as being unpatentable over Fairman.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the answer (Paper No. 16, mailed January 15, 2002) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 11, filed June 11, 2001) and reply brief (Paper No. 17, filed March 25, 2002) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The anticipation rejection

We sustain the rejection of claims 1 to 3, 5, 6, 10, 12, 13, 15 and 16 under 35 U.S.C. § 102(b), but not the rejection of claims 9, 11 and 19.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The inquiry as to whether a reference

anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984), it is only necessary for the claims to "'read on' something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or 'fully met' by it."

Claims 1, 9, 10, 11 and 19 read as follows:

1. An air conveyor guide rail comprising:
an elongate plate having top and bottom edges and upstream and downstream edges, a plurality of openings through the plate within the top, bottom, upstream and downstream edges of the plate for allowing a free flow of air through the plate, and attachment means for attaching the plate to the air conveyor.
9. The air conveyor guide rail of Claim 1, wherein:
the top and bottom edges of the plate are parallel to each other and the upstream and downstream edges of the plate are parallel to each other.
10. Air conveyor guide rails comprising:
a pair of elongated plates, each plate having top and bottom edges and upstream and downstream edges, a plurality of openings through each plate within the top, bottom, upstream and downstream edges of each plate for allowing a free flow of air through the plate, and attachment means for attaching the plate to the air conveyor.
11. The air conveyor guide rails of Claim 10, wherein:
the pair of plates are mirror images of each other.

19. The air conveyor guide rails of Claim 10, wherein:
the top and bottom edges of the pair of plates are parallel to each other
and the upstream and downstream edges of the pair of plates are parallel to
each other.

The invention of Lenhart '423 relates to an air conveyor apparatus for use with generally cylindrical lightweight containers and more particularly to a damperless conveyor which controls the conveying speed of the containers whether en masse or in a sparse or individual flow of containers. As shown in Figures 1-5, a conveyor C is provided which has a conveying surface in the form of a deck 12 with a plurality of louvers L therein for conveying lightweight containers 16 from an upstream location to a downstream location. A plenum 18 is attached to the bottom side of deck 12 and is supplied by air from a common air supply, such as a blower (not shown) through an inlet 20. Open guide rails 22 are provided along the outboard edges of deck 12 to hold the containers on the conveying surface. As shown most clearly in Figures 1-2, one open guide rail 22 is provided on one side of the conveyor C and another open guide rail 22 is provided on the other side of the conveyor C. As best shown in Figure 1, each open rail 22 includes an upper horizontal bar and a lower horizontal bar spaced apart by vertical bars so as to create openings therebetween.

As seen in Figure 3, the air passes through the louvers and, due to the Coanda Effect, travels along the surface of the deck in the direction of arrows D. The flow of air

emitted from the louvers creates a low pressure area thereby holding the bottom 26 of container 16 closely adjacent the deck 12. Ambient air is drawn in through the openings in the guide rails 22, as depicted by arrows 27 in Figure 9, which assists in moving the containers in the downstream direction.

Claims 1 and 10

The appellant argues (brief, pp. 9-11; reply brief, pp. 1-2) that claims 1 and 10 are not anticipated by Lenhart '423 since (1) the guide rails 22 of Lenhart '423 are not an elongated plate¹ as recited in claims 1 and 10; and (2) the guide rails 22 of Lenhart '423 do not disclose downstream and upstream edges as recited in claims 1 and 10. Specifically, the appellant states that an artisan viewing the guide rail 22 of Lenhart '423 would not consider it to be an elongate plate having top and bottom edges and upstream and downstream edges and a plurality of openings within the plate edges as recited in claims 1 and 10.

In our view, the subject matter of claims 1 and 10 is readable on the guide rails 22 of Lenhart '423. The claimed "elongated plate" is, in our opinion, readable on each of the guide rails 22 of Lenhart '423 since each guide rail 22 is, as shown in Figures 1-

¹ The appellant states (brief, pp. 5-6 & 9) that the word "plate" as used in the application has its ordinary and accustomed meaning of a smooth, flat, relatively thin piece of material (The American Heritage Dictionary).

2, a smooth, flat, relatively thin piece of material. The claimed upstream edge is readable on the upstream end of either the upper horizontal bar or the lower horizontal bar of the guide rail 22. Likewise, the claimed downstream edge is readable on the downstream end of either the upper horizontal bar or the lower horizontal bar of the guide rail 22. While the downstream edge of the upper horizontal bar and the downstream edge of the lower horizontal bar are not shown in the drawings, it is our determination that such are inherent from the disclosure of Lenhart '423. Thus, it is our conclusion that an artisan viewing the guide rail 22 of Lenhart '423 would consider the guide rail 22 to be an elongate plate having top and bottom edges and upstream and downstream edges and a plurality of openings within the plate edges as recited in claims 1 and 10.

For the reasons set forth above, the decision of the examiner to reject claims 1 and 10 under 35 U.S.C. § 102(b) is affirmed.

Claims 2, 3, 5, 6, 12, 13, 15 and 16

The appellant has grouped claims 1, 2, 3, 5, and 6 as standing or falling together.² The appellant has also grouped claims 10, 12, 13, 15 and 16 as standing or

² See pages 8 and 10 of the appellant's brief.

falling together.³ Thereby, in accordance with 37 CFR § 1.192(c)(7), claims 2, 3, 5, and 6 fall with claim 1 and claims 12, 13, 15 and 16 fall with claim 10. Thus, it follows that the decision of the examiner to reject claim 2, 3, 5, 6, 12, 13, 15 and 16 under 35 U.S.C. § 102(b) is also affirmed.

Claims 9 and 19

The appellant argues (brief, pp. 10-12) that claims 9 and 19 are not anticipated by Lenhart '423 since the guide rails 22 of Lenhart '423 do not have upstream and downstream edges which are parallel to each other. We agree. While we believe that it is inherent that the guide rail 22 of Lenhart '423 has a downstream edge, it is our view that it is not inherent that such downstream edge be parallel to the upstream edge depicted in Figure 1.

Since all the limitations of claims 9 and 19 are not disclosed by Lenhart '423 for the reason set forth above, the decision of the examiner to reject claims 9 and 19 under 35 U.S.C. § 102(b) is reversed.

³ See pages 8 and 11 of the appellant's brief.

Claim 11

The appellant argues (brief, p. 11; reply brief, p. 3) that claim 11 is not anticipated by Lenhart '423 since the guide rails 22 of Lenhart '423 are not mirror images of each other. We agree. Since the downstream part of the guide rails 22 of Lenhart '423 are not shown or described, it is our view that it is not inherent that the guide rails 22 of Lenhart '423 are mirror images of each other.

Since all the limitations of claim 11 are not disclosed by Lenhart '423 for the reason set forth above, the decision of the examiner to reject claim 11 under 35 U.S.C. § 102(b) is reversed.

The obviousness rejections

We will not sustain the rejection of claims 1 to 19 under 35 U.S.C. § 103 as being unpatentable over Lenhart '307 or the rejection of claims 1 to 19 under 35 U.S.C. § 103 as being unpatentable over Fairman for the reasons set forth by the appellant in the brief (pp. 12-17 & 20-21) and the reply brief (pp. 3-5).

In both of these rejections (answer, pp. 4-6) the examiner (1) ascertained that both Lenhart '307 and Fairman did not disclose the recited limitation of an elongated plate; and (2) concluded that it would have been obvious to have formed the guide rail

system of both Lenhart '307 (rails 22 supported by brackets as shown in Figure 1) and Fairman (guide rails 71 and 72 supported by arms 63 as shown in Figures 1-2) as an elongated plate. We do not agree since the examiner has not provided any **evidence** in these rejections why the proposed modification would have been obvious at the time the invention was made to a person of ordinary skill in the art.

Evidence of a suggestion, teaching, or motivation to modify a reference may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), Para-Ordinance Mfg., Inc. v. SGS Importers Int'l., Inc., 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), cert. denied, 117 S. Ct. 80 (1996), although "the suggestion more often comes from the teachings of the pertinent references," In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). The range of sources available, however, does not diminish the requirement for actual evidence. A broad conclusory statement regarding the obviousness of modifying a reference, standing alone, is not "evidence." See In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002). See also In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if it would have been obvious at the time the invention was made to a person of ordinary skill in the art to form the separate parts of the guide rail system of both Lenhart '307 and Fairman as one-piece, such does not result in the claimed "elongate plate" since the resulting structure, in our opinion, would still not be a plate. Additionally, we wish to point out to the examiner that there is no requirement in 35 U.S.C. § 103 for a claimed invention to present novel or unexpected results over the prior art (e.g., the claimed invention does not have to perform better than the prior art).

For the reasons set forth above, the decision of the examiner to reject claims 1 to 19 under 35 U.S.C. § 103 is reversed.

REMAND

This application is being remanded to the examiner for consideration of the following items: (1) while the subject matter of claims 9, 11 and 19 is not anticipated under 35 U.S.C. § 102 by Lenhart '423 for the reasons set forth above, the patentability of claims 9, 11 and 19 under 35 U.S.C. § 103 over Lenhart '423 alone, or in combination with other prior art, should be evaluated; and (2) the patentability of claims

1 to 3, 5, 6 and 9 under 35 U.S.C. §§ 102 and 103 over Fairman's cover 55 should be determined.⁴

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 3, 5, 6, 10, 12, 13, 15 and 16 under 35 U.S.C. § 102(b) is affirmed; the decision of the examiner to reject claims 9, 11 and 19 under 35 U.S.C. § 102(b) is reversed; and the decision of the examiner to reject claims 1 to 19 under 35 U.S.C. § 103 is reversed. In addition, the application has been remanded to the examiner for further consideration.

⁴ The examiner raised this issue in the last paragraph on page 7 of the answer. However, as correctly pointed out by the appellant in the reply brief (p. 5), this construction is inconsistent with the rejection as set forth in both the final rejection and the answer (which under our rules may not contain a new ground of rejection) and as such is not before us in this appeal.

No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART; REMANDED

IRWIN CHARLES COHEN
Administrative Patent Judge

NEAL E. ABRAMS
Administrative Patent Judge

JEFFREY V. NASE
Administrative Patent Judge

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